

REMARKS

This Application has been carefully reviewed in light of the Decision on Appeal mailed August 28, 2009, and Final Office Action mailed September 17, 2007. At the time of the Final Office Action, claims 16-30 were pending in this Application. Claims 16-30 were rejected. Claims 1-15 were previously canceled. Claims 16, 23, and 30 have been amended to further define Applicants' invention. Applicants respectfully request reconsideration and favorable action in this case.

Rejections under 35 U.S.C. § 112

Claims 16-30 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner concludes that the term "polling specific subscriber data of the wireless local network for the logical connection" is indefinite since it is allegedly unclear what that phrase means. (Final Office Action, Page 4-5.) The Examiner further concludes that this phrase is "open ended." (Final Office Action, Page 4-5.)

Applicants respectfully disagree and submit that the claims are definite, and that they particularly point out and distinctly claim the subject matter of the invention. Applicants cannot find any basis under MPEP 706.03(d) upon which the present rejection is based. Applicants believe that the meaning and scope of the claimed terminology is clear from a basic reading of the claim language in light of the specification (*e.g.*, paragraphs [0013]-[0015]). Regarding the Examiner's "open ended" conclusion, Applicants can only find support for such a rejection in MPEP 2173.05(c)—but that section relates to "numerical ranges and amount limitations," neither of which are present in the currently amended claims.

For at least the foregoing reasons, Applicants request reconsideration and removal of the rejection of Claims 16-30 under 35 U.S.C. § 112.

Rejections under 35 U.S.C. § 103

Claims 16, 17, 19, 23, 24, 26, and 30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication No. 2004/0043791A1 by Gautam G. Reddy (“*Reddy*”) in view of U.S. Patent No. 6,078,811 issued to Yi-Bing Lin, et al. (“*Lin*”).

Claims 18 and 25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Reddy* in view of *Lin* and further in view of U.S. Patent No. 6,556,820 issued to Khiem Le, et al. (“*Le*”).

Claims 20-22 and 27-29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Reddy* in view of *Lin* and further in view of 3GPP TS 31.111 version 4.5.0 Release 4, 2001-12.

Applicants respectfully submit the cited art combinations, even if proper, which Applicants do not concede, do not render the claimed embodiment of the invention obvious.

In order to establish a prima facie case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Even if each limitation is disclosed in a combination of references, however, a claim composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR Int’l. Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007). Rather, the Examiner must identify an apparent reason to combine the known elements in the fashion claimed. *Id.* “Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.* (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). Finally, the reason must be free of the distortion caused by hindsight bias and may not rely on ex post reasoning. *KSR*, 127 S. Ct. at 1742. In addition, evidence that such a combination was uniquely challenging or difficult tends to show that a claim was not obvious. *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007) (citing *KSR*, 127 S. Ct. at 1741).

As mentioned above, independent Claims 16, 23, and 30 stand rejected under 35 U.S.C. § 103(a) based on *Reddy* in view of *Lin*. Applicants have amended independent Claims 16, 23,

and 30 to recite “monitoring activity of the wireless local network” where “the activity [is] based on establishing a connection between the terminal station and the wireless local network.” Applicants respectfully submit that these amendments are supported by the specification, for example, in paragraphs [0035], which discloses an established connection as a consequence of the connection setup mentioned in the description relating to Figure 5.

The Examiner alleges that *Reddy* teaches monitoring activity of the wireless local network, and specifically that *Reddy*’s disclosure of “searching for cell” teaches this monitoring. (Final Office Action, Page 7.) Applicants respectfully submit, however, that the system in *Reddy* does not disclose or teach “monitoring activity of the wireless local network . . . , the activity based on establishing a connection between the terminal station and the wireless local network,” as recited in the amended independent claims. Instead, and as the Examiner apparently concedes, *Reddy*’s “searching for cell” occurs prior to the time the *Reddy* system establishes a connection with the UTRAN:

. . . information is transferred from the USIM or SIM card 115 to the handset 110 for facilitating an initial cell search and to camp on the cell determined from the search – S2. After successful camping on a cell MS or UE receives system information. A communication link between the MS or UE 105 and a UTRAN node 120 is established

(Final Office Action, Page 7; *see also Reddy* at [0007].)

This disclosure in *Reddy* refers to the fact that a wireless station has to listen if any traffic is on the channel in order to avoid collision with other traffic. When the wireless station determines that it is safe to establish a connection (i.e., no collision will occur), it then establishes the connection. Thus, the “searching for cell” cannot be the same as the claimed “monitoring activity of the wireless local network . . . , the activity based on establishing a connection between the terminal station and the wireless local network” because *Reddy*’s wireless station has not yet established a connection when it is “searching for cell.”

Indeed, this fact is expressly conceded at page 6 of the decision by the Board of Patent Appeals and Interferences mailed August 28, 2009: “In a wireless local network environment, *Reddy* would have to monitor the activity of an existing connection *in order to establish*

connection.” (Emphasis added.) In other words, while “searching for cell,” the *Reddy* system monitors the activity of connections that exist between the wireless local network and other wireless stations, not the wireless station attempting to establish a connection—i.e., the “terminal station” of Claim 16. Again, the *Reddy* system does this because it must determine if it is safe for the wireless station to establish a connection (i.e., doing so will not cause a collision with these other wireless stations). If, after monitoring those existing connections between the network and the other stations, the wireless station (i.e., the “terminal station” of Claim 16) determines that no collision will occur, it proceeds to establish a connection with the wireless local network. Because the wireless station’s monitoring of the activity occurs prior to establishing a connection, however, *Reddy*’s monitoring does not monitor activity “based on establishing a connection between the terminal station and the wireless local network.”

In addition, amended independent Claims 16, 23, and 30 recite transmission of “at least one of a type and an identity number . . . following successful detection of local network activity indicating an established connection between the terminal station and the wireless local network.” Applicants respectfully submit that *Reddy* fails to disclose this feature of Applicants’ invention. As just discussed, any monitoring performed by *Reddy* involves monitoring the activity of other wireless stations. Thus, *Reddy* does not disclose detection of “activity indicating an established connection between the terminal station and the wireless local network,” as recited in the independent claims.

For at least these reasons, Applicants submit that *Reddy* fails to disclose all the features of amended independent claims 16, 23, and 30, and therefore cannot render these claims obvious. Given that Claims 17-22 depend from Claim 16, and Claims 24-29 depends from Claim 23, Claims 17-22 and 24-29 are also allowable. Thus, Applicants respectfully request reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a), and full allowance of Claims 16-30. Applicants reserve the right to make further arguments regarding the Examiner’s rejection under 35 U.S.C. § 103(a), if necessary, and do not concede that the Examiner’s proposed combinations are proper.

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Request for Continued Examination (RCE)

Applicants enclose a Request for Continued Examination (RCE) Transmittal and authorize the Commissioner to charge \$810.00 for the RCE fee to Deposit Account No. 50-4871 of King & Spalding L.L.P.

CONCLUSION

Applicants have made an earnest effort to place this case in condition for allowance in light of the remarks set forth above. Applicants respectfully request reconsideration of the pending claims.

As discussed above, Applicants enclose a Request for Continued Examination (RCE) Transmittal and authorize the Commissioner to charge \$810.00 for the RCE fee to Deposit Account No. 50-4871 of King & Spalding L.L.P.

Applicants believe there are no other fees due at this time. However, the Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 50-4871 of King & Spalding L.L.P.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512-457-2030.

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